

GF-2624

Docket No.: LE9-99-051

PATENT

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Heraldine Bueck

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Rasche et al. : Paper No.:
Serial No.: 09/610,129 : Group Art Unit: 2624
Filed: July 5, 2000 : Examiner: K. Poon
For: Photoprinter Access To Remote Data

Assistant Commissioner for Patents
Washington, DC 20231

Dear Sir:

Transmitted herewith is a Request For Reconsideration in the above identified application.

☒ No additional fee is required.

☐

The fee has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUS PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims	19	20	0	x \$18 =	\$0.00
Independent Claims	4	4	0	x \$80 =	\$0.00
TOTAL FEE DUE					\$0.00

☐ A check in the amount of \$0.00 is enclosed.

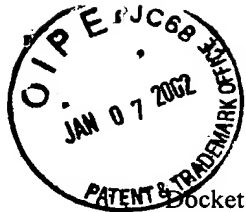
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Respectfully submitted,

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276591.01 LE138-100014



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Docket No.: LE9-99-051

PATENT

CERTIFICATE OF MAILING

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Assistant Commissioner for Patents, Washington, DC 20231

on December 14, 2001.

Herbert A. Bredt

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Rasche et al : Paper No.:
Serial No.: 09/610,129 : Group Art Unit: 2624
Filed: July 5, 2000 : Examiner: K. Poon
For: **Photoprinter Access To Remote Data**

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REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

The Official Action dated September 14, 2001 has been carefully considered. Accordingly, taken with the following remarks it is believed the present application is in condition for allowance. Reconsideration is respectfully requested.

In the Official Action, claims 1-7, 9 and 11-13 were rejected under 35 U.S.C. §102(e) as being anticipated by Itoh (U.S. Patent No. 6,034,785). The Examiner asserts that Itoh teaches a printer configuration comprising a computer readable medium comprising data, a computer having access to the data on the computer readable medium, a communication link connected to the computer, a photoprinter connected to the communication link and in communication with the computer, the photoprinter having a selection mechanism, and having access to the data over

the communication link and memory in response to the user's input to the selection mechanism on the photoprinter.

However, as will be set forth in detail below, it is submitted that the printer configurations and method for accessing digital photographs defined by claims 1-7, 9, and 11-13 are not anticipated by the teachings of Itoh. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, the present invention is directed towards a printer configuration, comprising a computer readable medium comprising data, a computer having access to the data on the computer readable medium, a communication link connected to the computer, a photoprinter connected to the communication link and in communication with the computer, wherein the photoprinter has a selection mechanism and has access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter.

Itoh discloses a digital print system, wherein the digital print system comprises an image input device, a controller, a printer, a display, a memory device, an input device, and a bonding machine for bonding a print in which characters in an image output from the printer are synthesized onto a based card such as a New Year's post card or standard postal card. In the Official Action the Examiner has asserted that the digital print system 10 shown in Fig. 1 of Itoh is a photoprinter. However, the Examiner's attention is directed to column 6, lines 4-39 of Itoh which teaches the digital print system 10 is a printer configuration which comprises multiple components, of which one component being a printer 16. However, Itoh fails to teach or suggest a photoprinter. As defined by the present invention, a photoprinter is a stand-alone appliance for printing digital photographs onto a printable medium (see p. 3, lines 15-26 of the present specifications). The printer of Itoh fails to teach or suggest a stand-alone appliance for printing digital photographs onto a printable medium and Itoh fails to teach or suggest a printer, which

is capable of processing and printing digital files independent of an external host device, such as a computer.

In addition, Itoh fails to teach or suggest a photoprinter having a selection mechanism on the photoprinter, which allows access to data over a communication link in response to a user's input to the selection mechanism on the photoprinter. The Examiner has asserted that the selection mechanism (22a and 22b) in Fig. 1 of Itoh is on the printer 16. While Itoh discloses a data input device 22 (see column 6, lines 4-30), the data input device (22a,22b) is not on the printer, but rather is in communication with the controller (14) which is also in communication with the printer 16 (see Fig. 1 of Itoh).

Applicants find no teaching or suggestion by Itoh of a photoprinter as defined by the present invention. In addition, Applicants find no teaching or suggestion by Itoh of a selection mechanism on the photoprinter as required by the present claims.

Rejection for anticipation or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed.Cir.), *cert denied*, 110 S.Ct. 154 (1989). Applicants are unable to find any teaching or disclosure by Itoh of a photoprinter comprising a stand-alone appliance for printing digital photographs onto a printable medium. Moreover, Applicants find no teaching or suggestion by Itoh of a selection mechanism on the photoprinter, wherein the selection mechanism has access to data over the communication link in response to users input to the selection mechanism on the photoprinter.

Further, the reference must describe the Applicant's claimed invention sufficiently to place a person of ordinary skill in the field of the invention in possession of it. *Akzo N. V. v. United States Int'l Trade Comm'n*, 808 F.2d 1471, 1479, 1U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986), *cert denied*, 482 U.S. 909 (1987); *In re Coker*, 463 F.2d 1344, 1348, 175 U.S.P.Q. 26, 29

(CCPA 1972). To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 U.S.P.Q.2d 1286, 1291 (Fed. Cir. 2001); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Applicants find no teaching or disclosure in Itoh of a photoprinter connected to the communication link of the printer configuration. The photoprinter as defined by the present invention means a stand-alone appliance for printing digital photographs onto a printable medium. By stand-alone, means that the printer is capable of processing and printing digital files independent of external host device, such as a computer, wherein processing means calculating a pixel pattern to be printed on the printable medium that represents the corresponding digital file (see lines 19-30 of page 3 of the present application). Furthermore, Applicants find no teaching or suggestion of a photoprinter having a selection mechanism and having access to the data over the communication link in response to a user's input to selection mechanism on the photoprinter. Itoh fails to teach or suggest a photoprinter with a selection mechanism, whereby Itoh fails to anticipate the presently claimed printer configuration and methods.

The present invention as defined by claim 11 comprises a printer configuration comprising a computer having a plurality of digital photographs on computer readable medium, a communication link connected to the computer, and a photoprinter connected to the computer via the communication link wherein the photoprinter has a means for accessing the digital photographs.

As noted above, Itoh fails to teach or suggest a photoprinter and a photoprinter having means for accessing digital photographs. The Examiner's rejection identifies the means as being 22a and 22b in Fig. 1 of Itoh for accessing the digital photographs through the photoprinter. However, the Examiner's attention is directed to Fig. 1 of Itoh, wherein printer 16 is independent

from the input means 22a and 22b. The Examiner apparently has confused the digital print system 10 with a printer. Itoh teaches a digital print system comprised of a configuration of multiple components, wherein one component is a printer 16 (see column 6, lines 1-40).

Furthermore, Itoh fails to teach or suggest that the input means 22a and 22b have the capability for accessing digital photographs over the communication link to the computer having a plurality of digital photographs on the computer readable medium. As noted above, a rejection for anticipation for lack of novelty requires, as a first step, that all the elements of the claimed invention be described in a single reference. *Richardson v. Suzuki Motor Co., supra*. Itoh fails to teach or suggest a photoprinter in a printer configuration, wherein the photoprinter is connected to a computer via a communication link, and photoprinter having means for accessing the digital photographs through the communication link to the computer having a plurality of digital photographs on a computer readable medium. Thus, Itoh by its failure to teach or suggest all the claimed elements of the Applicant's claimed invention does not support a rejection under 35 U.S.C. §102. It is therefore submitted that the presently claimed printer configurations and methods are not anticipated by Itoh, whereby the rejection under 35 U.S.C. §102 (e) has been overcome. Reconsideration is respectfully requested.

In the Official Action, the Examiner rejected claims 15-17 under 35 U.S.C. §102 (b) as being anticipated by Colbert et al. (U.S. Patent No. 5,699,494). The Examiner asserted that Colbert et al. teach a method for diagnosing a printer, the method comprising the steps of obtaining a stand-alone printer, establishing a communication link between the stand-alone printer and a computer and transmitting instructions over the communication link from the computer to the stand-alone printer and diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions.

However, as will be set forth in detail below, it is submitted that the methods for diagnosing a printer defined by claims 15-17 are not anticipated by Colbert et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

Colbert et al. disclose a remote replication of a printer operation panel between a host computer and a conventional printer connected to the host, either locally or by way of a network. The host computer is provided with access to a visual and functional replica of the operator panel of the printer. The user may view the replica to access all data available through the printer operational panel.

The present invention as defined by claim 15 requires a stand-alone printer. Colbert et al. fail to teach or suggest a stand-alone printer. A stand-alone printer is a printer capable of processing and printing digital files independent of an external host device, such as a computer, wherein processing means calculating a pixel pattern to be printed on the printable medium that represents the corresponding digital file (see page 3, lines 15-30). The Examiner asserts in the rejection that printer 16 in Fig. 1 of Colbert et al. is a stand-alone printer. However, Applicants find no teaching or suggestion that the conventional printer 16 in Fig. 1 is a stand-alone printer or has stand-alone capabilities or functionality. Furthermore, Applicants find no teaching or suggestion from Colbert et al. of a stand-alone printer having the capability of diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions from an external host. To anticipate, every element and limitation of the claimed invention must be found in the single prior art reference, arranged as in the claim. *Karsten Manufacturing Corp. v. Cleveland Golf Co., supra.* A rejection for anticipation or lack of novelty requires, as a first step in the inquiry, that all the elements of the claimed invention be described in a single reference. *Richardson v. Suzuki Motor Co., supra.* Further, the reference must describe the Applicants claimed invention sufficiently to place a person of ordinary skill in the art of the

invention in possession of it. *Akzo N.V. v. United States Int'l Trade Comm'n, supra*. Finding no teaching or suggestion in Colbert et al. of a stand-alone printer or a printer having the capability of diagnosing one or more functions of a stand-alone printer, Colbert et al. fail to teach or suggest the methods for diagnosing a printer as currently defined by claims 15-17 and therefore do not anticipate the presently claimed invention. Whereby, the rejection has been overcome and reconsideration is respectfully requested.

In the Official Action, claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Itoh as applied to claim 1 above, and further in view of Satomi et al. (U.S. Patent No. 4,759,053). The Examiner noted that Itoh does not teach the communication link comprising a modem connection. The Examiner asserts that Satomi et al. teach to use a modem connecting a computer and a printing device as a communication link. The Examiner asserted that it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Itoh to include a modem connection as a communication link. The Examiner asserted that it would have allowed the printer and the computer to be far apart and a user would still use the system and using a modem connection would have allowed the printer and computer to be located any location so long as there is a phone line and would have provided users with convenience.

However, as will be set forth in detail below, it is submitted that the printer configuration of claim 8 is non-obvious and patentably distinguishable from the teachings of Itoh in further view of Satomi et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 8, the present invention is directed towards a printer configuration of claim 1, further comprising the communications link being a modem connection.

As noted above, Itoh discloses a digital print system that lacks several features and elements of the claimed invention. These missing features include a photoprinter connected to the communication link and in communication with the computer wherein the photoprinter has a selection mechanism having access to the data over the communication link in response to a user's input to the selection mechanism on the photoprinter. As noted above, the printer of Itoh does not have a selection mechanism on the printer.

Satomi et al disclose a facsimile/character communication system capable of transmitting or receiving character data through a host computer intermediately storing the character or picture data.

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979).

Applicants find no teaching or suggestion by Itoh alone or in combination with Satomi et al. of a stand-alone photoprinter. As defined by the present specification, a photoprinter is a stand-alone appliance for printing digital photographs onto a printable medium (see p.3, lines 15-36). In addition, Itoh and Satomi et al., alone or in combination, fail to teach or suggest a photoprinter having a selection mechanism on the photoprinter.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). In view of the failure of Itoh and Satomi et al., alone or in combination to teach, disclose or suggest a stand-alone photoprinter with a selection mechanism on the photoprinter, Itoh and Satomi et al. do not render the presently claimed printer configurations obvious. It is therefore submitted that the presently claimed printer configurations are non-obvious over and

patentably distinguishable from Itoh in view of Satomi et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

In the Official Action, claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Itoh and further in view of Bahreman (U.S. Patent No. 6,061,665). The Examiner noted that Itoh does not teach the data being accessible on an online account. The Examiner asserted that Bahreman teaches data from a server is accessible on an online account. The Examiner asserted that it would have been obvious to a person of ordinary skill in the art to modify Itoh to include print data accessible on an online account.

However, as will be set forth in detail below, it is submitted that the printer configuration of claim 10 is non-obvious and patentably distinguishable from the teachings of Itoh in further view of Bahreman.

Bahreman discloses a system for secure, electronic payment in exchange for goods and services purchased over a communication network utilizing a negotiated mutually accepted payment processing method from a customer to a merchant utilizing a network.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d. 1941 (Fed.Cir. 1992). Similarly, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In re Geiger*, U.S.P.Q.2d. 1276 (Fed. Cir. 1987). Applicants find no such teaching, suggestion or incentive for the combination of Itoh and Bahreman. One skilled in the art would not have been motivated to combine the e-commerce payment system of Bahreman with the image synthesizing method of Itoh.

It is therefore submitted that the presently claimed printer configurations are non-obvious over and patentably distinguishable from Itoh in view of Bahreman, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Itoh in further view of Lightenberg et al (U.S. Patent No. 5,682,441). The Examiner noted that Itoh does not teach or suggest downloading thumbnail representation of digital photographs. The Examiner asserts that Lightenberg et al teach downloading thumbnail representations of the digital photographs. The Examiner asserted it would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify Itoh to include downloading thumbnail representations of the digital photographs.

However, as will be set forth in detail below, it is submitted that the method for accessing digital photographs of claim 14 is non-obvious and patentably distinguishable from the teachings of Itoh in further view of Lightenberg et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 14, the present invention is directed towards a method for accessing digital photographs. The method comprises the steps of placing one or more digital photographs on a computer; establishing a communication link between a photoprinter and the computer; inputting a request to the photoprinter by a user; and accessing the digital photographs by the photoprinter in response to the request, wherein the step of accessing comprises downloading thumbnail representations of the digital photographs.

As noted above, Itoh fails to teach or suggest a stand-alone photoprinter. Furthermore, Applicants find no teaching or suggestion of a photoprinter with the ability to access digital photographs in response to a user's request on the photoprinter.

Ligtenberg et al. disclose image data formats and techniques for selectively storing and retrieving image data.

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne, supra*. The deficiencies of Itoh noted above are not overcoming by the combination of Lightenberg et al. Applicants find no teaching or suggestion by Itoh or Lightenberg et al., alone or in combination, of a stand-alone photoprinter. In addition, Itoh and Lightenberg et al., alone or in combination, fail to teach or suggest a photoprinter with the ability to access digital photographs in response to a user's request on the photoprinter.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka, supra*. In view of the failure of Itoh and Lightenberg et al., alone or in combination, to teach or suggest a stand-alone photoprinter having the ability of accessing digital photographs in response to requests input to the photoprinter. Itoh and Lightenberg et al. do not render the presently claimed methods of accessing digital photographs obvious. It is therefore submitted that the presently claimed methods are non-obvious over and patentably distinguishable from Itoh in view of Lightenberg et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Colbert et al. in further view of Itoh. The Examiner noted that Colbert et al. do not teach or suggest that the stand-alone printer is a photoprinter. The Examiner asserted that Itoh teaches that the stand-alone printer is a photoprinter. The Examiner asserted that it would have been obvious for a person with ordinary skill in the art to have modified Colbert et al. with the photoprinter of Itoh.

However, as will be set forth in detail below, it is submitted that the method for diagnosing a printer of claim 18 is non-obvious and patentably distinguishable from the teachings of Colbert et al. in view of Itoh et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 18, the present invention is directed towards a method for diagnosing a printer. The method comprises the steps of: obtaining a stand-alone printer; establishing a communication link between the stand-alone printer and a computer; transmitting instructions over the communication link from the computer to the stand-alone printer; and diagnosing one or more functions of the stand-alone printer in accordance with the transmitted instructions, wherein the stand-alone printer is a photoprinter.

As noted above, Colbert et al. disclose a remote replication of a printer operation panel between a host computer and a conventional printer connected to the host, either locally or by way of a network. Colbert et al. fail to teach or suggest a stand-alone printer. As defined by the present invention, a stand-alone printer is a printer capable of processing and printing digital files independent of external host device, such as a computer, wherein processing means calculating a pixel pattern to be printed on the printable medium that represents the corresponding digital file.

Furthermore, as noted above, Itoh fails to teach or suggest a stand-alone appliance for printing digital photographs onto a printable medium and Itoh fails to teach or suggest a printer, which is capable of processing and printing digital files independent of an external host device, such as a computer.

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public.

In re Payne, supra. Applicants find no teaching or suggestion by Colbert et al. and Itoh, alone

or in combination of a stand-alone printer as defined by the present invention. Furthermore, Applicants find no teaching in Itoh of a stand-alone photoprinter as defined by the present invention.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka, supra*. In view of the failure of Colbert et al. and Itoh, alone or in combination to suggest a stand-alone printer, Colbert et al. and Itoh do not render the presently claimed methods for diagnosing a printer obvious. It is therefore submitted that the presently claimed methods are non-obvious and patentably distinguishable from Itoh in view of Lightenberg et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Colbert et al. in view of Overall et al. (U.S. Patent No. 5,797,061). The Examiner noted Colbert et al. fail to teach or suggest a computer receiving usage statistics of the stand-alone printer. The Examiner asserted that Overall et al. teach having a computer receive usage statistics of the printer. The Examiner asserted that it would have been obvious to one skilled in the art to modify Colbert et al. with Overall et al.

However, as will be set forth in detail below, it is submitted that the method for diagnosing a printer of claim 19 is non-obvious and patentably distinguishable from the teachings of Colbert et al. in view of Overall et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 19, the present invention is directed towards a method for diagnosing a printer. The method comprises the steps of: obtaining a stand-alone printer; establishing a communication link between the stand-alone printer and a computer; transmitting instructions over the communication link from the computer to the stand-alone printer, diagnosing one or

more functions of the stand-alone printer in accordance with the transmitted instruction; and receiving at the computer usage statistics of the stand-alone printer.

Overall et al. disclose a printer that calculates the remaining amount of pages that can be printed and time before the ink cartridge becomes empty.

References relied upon to support a rejection under 35 U.S.C. §103 must provide a enabling disclosure, i.e., they must place the claimed invention in the possession of the public, *In re Payne, supra*. The deficiencies of Colbert et al. noted above are not overcome by the combination of Overall et al. Applicants find no teaching or suggestion by Colbert et al. and Overall et al., alone or in combination, of a stand-alone printer as defined by the present invention.

In view of the failure of Colbert et al. and Overall et al., alone or in combination, to teach or suggest a stand-alone printer, Colbert et al. and Overall et al. do not render the presently claimed methods of diagnosing a printer obvious. It is therefore submitted that the presently claimed methods are non-obvious and patentably distinguishable from Colbert et al. in view of Overall et al., whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the Examiner's rejections under 35 U.S.C. §§102 and 103 and places the present application in condition for allowance. Reconsideration and an early allowance are requested

Respectfully submitted,

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